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OCT 04 2005
20107013Application No.: 10/686,811Docket No.: 2038-301**REMARKS**

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested. Entry of this Amendment under Rule 116 is merited as it raises no new issues and requires no further search.

The Examiner's indication of allowable subject matter of claims 2, 12, and 18 is noted with appreciation.

Claims 1-8 and 10-21 are pending in the application. Claims 1 and 6 have been amended to overcome the *35 U.S.C. 112, second paragraph* rejection. Otherwise, the rejected claims are substantively unchanged notwithstanding the Examiner's modified rejections. No new matter has been introduced through the foregoing amendments.

The *35 U.S.C. 112, second paragraph* rejection of claims 1, 3-5 and 6 is believed overcome in view of the above amendments.

The *35 U.S.C. 103(a)* rejections relying on *Bauer, JP '845* and *JP '638* are traversed, because the references are not combinable in the manner suggested by the Examiner to include all limitations of the rejected claims.

In particular, the Examiner's reliance on *JP '845* for nothing more than the pair of fold-guiding lines is improper. See the Final Office Action, at page 6, lines 3-5.

In accordance with proper USPTO practice and procedure, "[a]scertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole. See MPEP § 2111 - § 2116.01 for case law pertaining to claim interpretation. See also MPEP, sections 2141.02 and 2141 (BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:... (B) The references

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must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination) (emphasis added).

Thus, the *JP '845* reference must be considered as a whole, rather than only for the teachings that the Examiner wants to apply against the claimed invention. When considered as a whole, *JP '845* teaches away from the claimed invention, requiring that the absorbent core (element 3 in FIG. 2) be free of fold guiding lines, as best seen in FIG. 1 of *JP '845*. Thus, *JP '845* does not teach or suggest the claimed feature that the absorbent core is folded as recited in the rejected independent claims.

The Examiner's reliance on *JP '845* and *JP '638* also lacks a proper suggestion or motivation to combine the teaching references with the primary reference of *Bauer*. See the paragraph bridging pages 3-4 of the Final Office Action.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). See also *MPEP*, section 2143.

It is unclear as to whether the applied references or the knowledge generally available in the art supply/ies the Examiner's so-called suggestion or motivation to combine the references found at page 4, lines 1-2 of the Final Office Action. Clarification is respectfully requested.

In addition, Applicant respectfully submits that the teaching references do not supply the Examiner's suggestion or motivation, because the folding taught by the teaching references is not

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for better packaging, but for forming the respective diapers into a predetermined shape. The diapers of *JP '845* and *JP '638* are open diapers having an initial rectangular shape, and therefore need the disclosed folding to shape the initial rectangular body into a diaper form with leg openings. A person of ordinary skill in the art would recognize that if *Bauer* teaches a package of pull-on diapers, such pull-on or pant diapers would not need the folding taught by *JP '845* and *JP '638* because the pull-on diapers have already had the proper diaper shape. Thus, the person of ordinary skill in the art would not have been motivated to modify the *Bauer* package with the folding of *JP '845* and *JP '638*, because such folding, for the purpose of forming the garments into a diaper shape, would be redundant.

Withdrawal of all 35 *U.S.C. 103(a)* rejections manifested in the Final Office Action in view of the above is believed appropriate and therefore respectfully requested.

Accordingly, Applicants respectfully submit that all claims in the present application are in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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571-273-8300
FACSIMILE NUMBER